

REMARKS

Claims 1-34 are pending in the present application.

5

In the Final Office Action mailed 2 March 1999, the Examiner merely objected to claims 9-11, 20-22, and 31-33 as being dependent upon rejected base claims, but allowable if rewritten independent form. In response, the Applicants respectfully acknowledge Examiner's conditional allowance of such claims.

10

In the same Action, the Examiner finally rejected claims 1, 5-8, 12, 16-19, 23, 27-30, and 34 under 35 U.S.C. § 102(e) as being anticipated by Clark, II et al (U.S. Patent No. 5,686,912). In addition, the Examiner finally rejected claims 2-4, 13-15, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Clark, II et al. ("Clark"). In response, the Applicants respectfully submit that rejected claims 1-34 are allowable over Clark for the following reasons.

15

First, the Applicants respectfully submit that all claims include limitations such as "ceasing compression for subsequent data blocks ... if the compression fails to satisfy the predetermined compression criteria" (e.g., claim 1). In contrast, data compression in Clark continues throughout a raw mode, even though compressed data is not stored in the raw mode (see e.g., col. 2, lines 1-2: "generating a compressed data segment based on the raw data segment"). Put another way, Clark describes that compression activity does not terminate during its raw mode, such as described in FIG. 2 (i.e., block 38 shows compression of data throughout operation and without regard to mode). On the other hand, the present invention may "conserve valuable processor time by avoiding compression" (p.3 at line 16); see also Abstract: ceasing compression and thereby "saving ... processor time when data

20

25

compression is poor." Clark neither teaches nor concerns itself with such cessation or efficiency.

The Applicants submit that, for these reasons alone, claims 1-34 are clearly not anticipated under 35 U.S.C. § 102(e) by Clark.

5 **Second**, the Applicant respectfully submits that all claims are nonobvious over Clark as well with respect to the limitation "*ceasing compression*". For one, no secondary reference having any further teachings has been provided for combination with Clark for 35 U.S.C. § 103(a) purposes. Thus, no teaching or suggestion exists to make such a modification. In addition, it appears that continued data compression in Clark's raw mode is essential for its operation, since that data is used to determine the criteria for reentering the compressed mode when compression is good. Reading Clark in its entirety, the criteria generated from the compressed data is emphasized in Clark for operation, and continuous compression is indicated in that which is claimed therein. Based on the above, even if there were a teaching and a suggestion discovered: (a) Clark teaches away from such suggestion, and (b) to modify Clark as suggested would change its principle of operation and/or no reasonable expectation of success would be apparent.

10

15

20 **Third**, some claims further recite "user adjustable and programmable compression criteria" (see claim 23 and claims dependent therefrom). Clark do not teach nor suggest such limitation. Clark teaches at best that "the compression threshold may be set ..." (col. 4, lines 20-21). However, by "user adjustable and programmable" --- read in light of the specification (e.g., p. 11 at lines 3-10) -- it is clear that such parameters are adjustable by the operator or end user. Thus, the Applicant submits that these claims are further allowable over the prior art of record.

The Applicants respectfully request reconsideration of claims 1-8, 12-19, 23-30, and 34. In view of the remarks made in this paper, the Applicants submit that claims 1-34 overcome the prior art of record and the entire application is in a condition suitable for allowance.

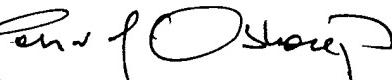
5

The Applicants believe there are no fees required for this Amendment, however, authorization is given to debit USPTO Deposit Account No. 09-0442 for any fee that may be due.

10

Should the Examiner have any questions regarding this Amendment, he is respectfully invited to telephone Applicants' undersigned attorney.

Respectfully submitted,



JOHN J. OSKOREP

Attorney for Applicant

Reg. No. 41,234

Date: 5 April 1999

GRAY CARY WARE & FREIDENRICH
401 B Street, Suite 1700
San Diego, California 92101

Telephone: (619) 699-2933 Fax: (619) 236-1048